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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/405,299 09/23/99 ALBERTE

R PHA-005.01

025181  
FOLEY, HOAG & ELIOT, LLP  
PATENT GROUP  
ONE POST OFFICE SQUARE  
BOSTON MA 02109

IM22/0313

EXAMINER

YAMNITZKY, M

ART UNIT PAPER NUMBER

1774

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DATE MAILED:

03/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.  
09/405,299

Applicant(s)

Randall S. ALBERTE et al.

Examiner

M. Yamnitzky

Group Art Unit

1774



Responsive to communication(s) filed on \_\_\_\_\_.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one (1) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-70 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-70 are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. This application contains claims directed to the following patentably distinct species of the claimed invention: the numerous compounds of general structure 1 as shown in claims 1 and 34 wherein

X represents (i) -OH, (ii) -O(aryl), (iii) -O(acyl), (iv) -O(sulfonyl), (v) -CN or (vi) F, Cl or Br;

Y represents (i) O, (ii) S, (iii) Se or (iv) NR;

Z represents optionally substituted (i) alkyl, (ii) heteroalkyl, (iii) cycloalkyl, (iv) heterocycloalkyl, (v) aryl, (vi) heteroaryl, (vii) aralkyl, (viii) heteroaralkyl, or (ix) -(CH<sub>2</sub>)<sub>m</sub>-R<sub>80</sub>;

R represents (i) hydrogen, (ii) alkyl, (iii) heteroalkyl, (iv) aryl, (v) heteroaryl, (vi) aralkyl, (vii) heteroaralkyl, or (viii) -(CH<sub>2</sub>)<sub>m</sub>-R<sub>80</sub>; and

R<sub>80</sub> represents (i) aryl, (ii) cycloalkyl, (iii) cycloalkenyl, (iv) heterocyclyl, or (v) polycyclyl.

This application also contains claims directed to the following patentably distinct species of the claimed invention: the various coating forms selected from (a) liquid, (b) gas/vapor, or (c) paste/semi-solid/solid.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. That is, applicant is required to elect one of (i)-(vi) for X, one of (i)-(iv) for Y, one of (i)-(ix) for Z, and one of (a)-(c). If (iv) is elected for Y, applicant is also required to elect one of (i)-(viii) for R. If (viii) is elected for R and/or (ix) is elected for Z, applicant is also

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required to elect one or two of (i)-(v) for R<sub>80</sub> (two may be elected if the elected species contains more than one -(CH<sub>2</sub>)<sub>m</sub>-R<sub>80</sub>). Currently, claims 1, 25-34 and 58-65 are generic.

Applicant is further required to identify an ultimate species of the compound of general structure 1, consonant with the elected species, that can be used as the starting point for search and examination purposes. An ultimate species is a specific (single) compound.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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2. No telephone call was made to request an oral election to the above election of species requirement due to the complexity of the requirement.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (703) 308-4413. The examiner can generally be reached at this number from 6:45 a.m. to 3:15 p.m. Monday-Friday.

The current fax numbers for Art Unit 1774 are (703) 305-3599 for official after final faxes and (703) 305-5408 for all other official faxes. (Unofficial faxes for Art Unit 1774 can be sent to (703) 305-5436.)

MRY  
03/13/00  
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*Marie R. Yamnitzky*

MARIE YAMNITZKY  
PRIMARY EXAMINER

*1774*